

REMARKS

All Claims Define Allowable Subject Matter

Claims 1, 2, 12 and 13 remain rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,123,003 to Noda et al. (hereinafter "Noda").

Claims 3 and 14 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of U.S. Patent No. 6,545,959 to Iida (hereinafter "Iida").

Claims 9 and 18 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of U.S. Patent No. 5,959,953 to Alon (hereinafter "Alon").

Claims 10, 11, 19 and 20 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of U.S. Patent No. 5,404,344 to Imada et al. (hereinafter "Imada").

Claims 4-8 and 15-17, while objected to as being dependent upon a rejected base claim, would be allowable if rewritten in independent form.

These rejections and objections are respectfully traversed for at least the following reasons.

Statement of Substance of Examiner Interview of August 25, 2005

Examiner Peter Vincent Agustin is thanked for the courtesies extended to Applicants' undersigned representative, Paul A. Fournier, together with Applicants representative John G. Smith in a telephone interview on August 25, 2005. During the interview, arguments such as those presented in the previous Responses filed on October 4, 2004 and March 14, 2005 were discussed in distinguishing features of independent claims 1 and 12 of the instant application

from the applied Noda reference. For example, arguments such as those presented in the second full paragraph of page 6 of the Response previously filed on October 4, 2004 were discussed.

As indicated on the Interview Summary Form (PTOL-413) issued by the Examiner following the interview, the Examiner was persuaded by Applicants' arguments in this regard. The Examiner indicated on the Interview Summary Form that the rejections applying Noda have been overcome. The Examiner goes on to note on the Interview Summary Form that "[u]pon the Applicants' filing of a written response, a new Office Action will be mailed following a new search on the pending claims." Accordingly, the instant Supplemental Response and Request for Reconsideration is filed in accordance with the Examiner's comments.

Rejections under 35 U.S.C. §§ 102(b) and 103(a)

Claims 1, 2, 12 and 13 remain rejected under 35 U.S.C. § 102(b) as being anticipated by Noda. Claims 3 and 14 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of Iida. Claims 9 and 18 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of Alon. Claims 10, 11, 19 and 20 remain rejected under 35 U.S.C. § 103(a) as being unpatentable over Noda as applied to claims 1 and 12, and further in view of Imada. These rejections are respectfully traversed for at least the same reasons as those presented in the previous Responses filed on October 4, 2004 and March 14, 2005.

In particular, Applicants respectfully submit that while col. 3, lines 3-5 of Noda discloses the generation of +/- second order diffracted light, there is no teaching or suggestion of utilizing this light in the manners recited in each of independent claims 1 and 12 of the instant application. For example, independent claim 1 recites an optical pickup device combination that includes an optical detector having first to fifth independent light-receiving elements. The fourth and fifth of

these light-receiving elements are described as “being adapted to receive returning light from the spots of the +/- second order diffracted light.” There is no teaching or suggestion in Noda of an optical detector having a light-receiving element configured to receive + or – second order diffracted light. The Examiner is thanked for his indication on the Interview Summary Form associated with the August 25, 2005 telephone interview that he is persuaded with these arguments and the rejections based on Noda have been overcome.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(e) and 103(a) should be withdrawn because Noda does not teach each feature of independent claims 1 and 12. As pointed out in MPEP § 2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” Thus, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).”

Moreover, with regard to the rejection under 35 U.S.C. § 103(a), Applicants respectfully submit that the applied second references to Iida, Alon and Imada fail to cure the deficiencies discussed above, and in the previously-filed Responses in this application, with regard to Noda. MPEP § 2143.03 instructs that “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974).” In addition, dependent claims 2-11 and 13-20 are allowable at least because of the dependence from their respective independent claims and the reasons set forth above.

The Examiner is thanked for the indication that claims 4-8 and 15-17, while objected to as being dependent upon a rejected base claim, include allowable subject matter. However,

Applicants respectfully request that the objection to these claims be withdrawn at least for the foregoing reasons.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration of this application, withdrawal of all rejections, and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0573. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

DRINKER, BIDDLE & REATH LLP

Dated: September 7, 2005

By:



Paul A. Fournier

Registration No. 41,023

Customer No. 55694

DRINKER, BIDDLE & REATH LLP

1500 K Street, N.W., Suite 1100

Washington, D.C. 20005-1209

Tel: (202) 842-8800

Fax: (202) 842-8465